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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,552

Applicant(s)

ORESICK ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8,9,12,13,18,19,21 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 8-9, 12-13, 18-19,21,52-58, 60-63 is/are rejected.
- 7) ☒ Claim(s) 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 5/25/06 to the application filed on 8/28/03.
2. Claims 3, 6-7, 10-11, 14-17, 20, 22-51 are canceled.
3. Claims 52-63 are added.
4. Claims 1-2, 4-5, 8-9, 12-13, 18-19, 21, 52-63 are pending in the case. Claims 1 and 57 are independent claims.
5. The rejections of claims 11, 36, and 46 under 35 USC 112, second paragraph, have been withdrawn in view of the cancellation of these claims.
6. The rejection of claim 21 under 35 USC 112, second paragraph, has been withdrawn in view of the amendment.

Claim Objections

7. Claims 1-2, 4-5, 8-9, 12-13, 18-19, 21, 52-63 are objected to since it is not necessary to include items in parentheses as in the amended claims. For example, method (100a [400], 100b [500], 100c[600]) or recipients (RECIPIENT 1-RECIPIENT N). It is suggested to remove these unnecessary items in the claims.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 18-19, 21, 54-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, determining step determines when the current document distribution job is complete but why including determining when all recipients of the one or more recipients have returned the document to the document distributing apparatus. Distributing a document is just *passing out* the document to one or more recipients and *the distribution is done when the recipients receive the document*. It appears that *returning the document from the recipients* does not mean anything of distributing when included in the distribution job.

Dependent claims 19, 21, 54-56 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2, 4-5, 18-19, 21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Auglin, Jr. et al. (US Pat No 5,892,591, 4/6/99, filed 11/22/96).

Regarding independent claim 1, Auglin discloses:

- providing a document to an included document distributing apparatus, the document comprising a cover sheet including a cover sheet information, the cover sheet information including a document distribution job information (figure 3, col 4, line 39 to col 5, line 9)
- receiving the document from the originator (col 4, lines 48-67)
- scanning the document to provide the document distribution job information (col 4, lines 48-67)
- distributing the document based on the document distribution job information to one or more recipients by means of an included communication network (col 5, lines 1-31: transmitting the document via the network computer over the Internet to one or more recipients based on the information on the cover sheet)
- receiving the document from the document distributing apparatus (col 5, lines 10-17; figure 3: the document is received in the destination facsimile from the remote computer, which is equivalent to the document distribution apparatus)
- subsequent to receiving the document, returning the document to the document distributing apparatus (col 5, lines 31-40)

Regarding claim 2, which is dependent on claim 1, Auglin discloses providing the document to the document distributing apparatus by means of the communication network (figures 2 and 3).

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Regarding claim 4, which is dependent on claim 1, Auglin discloses that the document distribution job information includes a message (abstract, col 4, lines 39-67).

Regarding claim 5, which is dependent on claim 1, Auglin discloses that the document distribution job information includes a routing information (abstract, col 4, lines 39-67, col 5, lines 1-17, figure 3).

Regarding claim 18, which is dependent on claim 1, Auglin discloses determining when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when all recipients of the one or more recipients have returned the document to the document distributing apparatus (col 5, lines 18-36)

Regarding claim 19, which is dependent on claim 18, Auglin discloses returning the document to the originator by the document distributing apparatus when it is determined the document distribution job is complete (col 5, lines 22-39).

Regarding claim 21, which is dependent on claim 18, Auglin discloses that it is determined that the current document job is not complete, continue to distribute the document (col 5, lines 22-30, col 6, lines 40-54).

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12. Claims 57-58, 60-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Auglin, Jr. et al. (US Pat No 5,892,591, 4/6/99, filed 11/22/96).

Regarding independent claim 57, Auglin discloses:

- receiving the document, the document comprising a document distribution job information (figure 3, col 4, line 39 to col 5, line 9)
- scanning the document to provide the document distribution job information (col 4, lines 48-67)
- distributing the document based on the document distribution job information to one or more recipients (col 5, lines 1-31: transmitting the document via the network computer over the Internet to one or more recipients based on the information on the cover sheet)
- subsequent to receiving the document, returning the document to the document distributing apparatus (col 5, lines 31-40)

Regarding claim 58, which is dependent on claim 57, Auglin discloses the document is received from the originator by means of the communication network (figures 2 and 3).

Regarding claim 60, which is dependent on claim 57, Auglin discloses determining when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when all recipients

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of the one or more recipients have returned the document to the document distributing apparatus (col 5, lines 18-36).

Regarding claim 61, which is dependent on claim 60, Auglin discloses returning the document to the originator by the document distributing apparatus when it is determined the document distribution job is complete (col 5, lines 22-39).

Regarding claim 62, which is dependent on claim 60, Auglin discloses that it is determined that the current document job is not complete, continue to distribute the document (col 5, lines 22-30, col 6, lines 40-54).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 8-9, 12-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Auglin as applied to claim 1 above, and further in view of Braun et al. (US Pat App Pub No 2004/0061888, 4/1/04, filed 9/20/02).

Regarding claims 8-9, which are dependent on claims 1 and 8 respectively, Auglin does not disclose, by at least one recipient of the one or more recipients, modifying the cover sheet information by marking the cover sheet with a marking instrument.

Braun discloses updating the facsimile cover sheet by a pen ([0007]).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to combined Braun into Auglin for easily editing the cover sheet information using a pen, which is a marking tool without using a keyboard.

Regarding claim 12, which is dependent on claim 1, Auglin does not disclose that the document comprising one or more document sheets including a document sheet information, the method including, by at least one recipient of the one or more recipients, modifying the document sheet information.

Braun discloses modifying the document sheet information ([0007]: updating the cover sheet shows modifying the document sheet information since the cover sheet includes the document information).

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It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Braun into Auglin for conveniently using a pen for modifying a facsimile as well as the facsimile cover sheet without the need of a keyboard of a computer.

Regarding claim 13, which is dependent on claim 12, Auglin does not disclose modifying the document sheet information by marking at least one document sheet with a marking instrument.

Braun discloses marking the cover sheet that is transmitted with one or more document sheets ([0007]: updating the facsimile cover sheet by a pen implies that the cover sheet is marked by a pen).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Braun to include marking at least one document sheet and combined Braun into Auglin for the following reason. Braun discloses marking the cover sheet of a document thus motivating to mark the document sheets since the document sheets and the cover sheet are documents transferred together. The combination of Braun into Auglin would provide an easy way to edit a transferred document with a pen.

16. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auglin as applied to claim 1 above, and further in view of Braun et al. (US Pat App Pub No 2004/0061888, 4/1/04, filed 9/20/02).

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Regarding claim 52, which is dependent on claim 1, Auglin does not disclose where at least one document that is returned to the document distributing apparatus contains cover sheet information that has been modified by at least one recipient of the one or more recipients.

Braun discloses updating the fax cover sheet by a pen ([0007]).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Braun into Auglin for easily editing the cover sheet information using a pen, which is a marking tool without using a keyboard.

Allowable Subject Matters

17. Claim 59 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

18. Applicant's arguments filed 5/25/06 have been fully considered but they are not persuasive.

Regarding claim 1, Applicants argue that Auglin does not disclose receiving the document from the document distributing apparatus, and subsequent to receiving the document, returning the document to the document distributing apparatus.

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However, these claimed limitations are merely the limitations of canceled claim 7 which is rejected in the previous office action, and there is no arguments from Applicant regarding these features.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harris (US 2003/0226885, filed 6/10/02).

Ericson et al. (US 2002/0054778, priority 5/30/00).

Woolf et al. (US 2004/0237033, priority 5/19/03).

Feig et al. (US 2006/0080317, priority 12/29/00).

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Mohit et al. (US 2005/0060162, priority 11/10/00).

Hendriks et al. (US 2003/0163525, filed 2/22/02).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
08/03/06